

Haugland et. al  
Serial No. 10/731,987

Docket No. MP0088

### **REMARKS**

#### **The Claimed Invention**

The claimed invention is directed to prenyloxysulfonic acid compounds, compositions, kits, and methods of use thereof.

#### **The Pending Claims**

Prior to consideration of the following Response to Restriction Requirement, Claims 1-25 were pending. Claims 26 and 27 have been newly added. Claims 1-10 are directed to prenyloxysulfonic acid compounds. Claims 11-18 are directed to fluorescent labeled conjugate compositions. Claims 19-22 are directed to methods for detecting analytes in a sample. Claims 23-25 are directed to kits for the detection of analytes.

#### **The Office Action**

Claims 1-25 are restricted.

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### **RESPONSE TO RESTRICTION REQUIREMENT**

In the response that follows, the Examiner's Election/Restriction of the Applicant's claimed invention is provided in full text, as identified by indented small bold print, followed by the Applicants response.

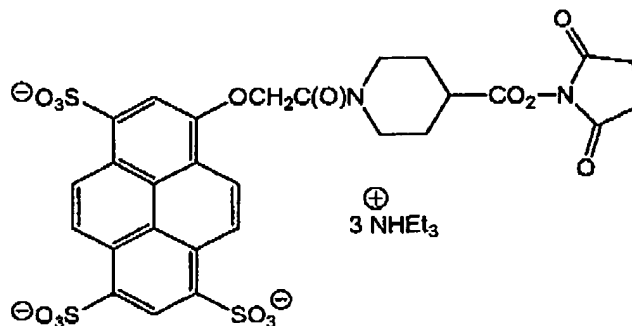
#### **35 U.S.C. § 121 Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. § 121

- I. Claims 1-5 and 8-10, drawn to compounds classified in class 564, subclass 123+.
- II. Claims 6-7, drawn to compounds, classified in class 548 and 546, in various subclasses.
- III. Claims 11-18, drawn to fluorescent-labeled conjugates, classified in class 514, 548 and 546, in various subclasses.
- IV. Claim 19 and 20, drawn to a method for detecting an analyte in a sample, classified in class 514, in various subclasses.
- V. Claim 21-22, drawn to a method for detecting a first and second analyte in a sample, classified in class 514, subclass 1+.
- VI. Claims 23-25, drawn to kits for the detection of analytes, classified in class 514, in various subclasses.

Applicants respectfully traverse the above restriction requirement and request reconsideration, but as required by CFR 1.143 Applicants provisionally elect group I. Applicants retain the right to prosecute the non-elected claims in a future continuation or divisional application.

For the purposes of initiating a search and examination of the present claims and as required by 37 CFR § 1.143, Applicants provisionally elect the species of Example 3, listed on page 55 of the specification. For the Examiners convenience, the structure is provided below:



The claims that read on the elected species include: 1, 3-7, and 10-27.

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According to the restriction requirement "Groups I-III are drawn to distinct compound[s] as demonstrated by the different structural formulae... Additionally, the inventions of Groups I-VI are independent and distinct because there is no patentable co-action among the groups..." Applicants respectfully point out that the claims of Group II (claims 6 and 7) are dependent on claim 1 of Group I. Accordingly, claims 6 and 7 differ in structure with claim 1 in that they are subgeneric (much in the same way claims 2-5 and 8-10 are subgeneric to claim 1). Particularly, the structure in claim 6 specifies that  $R^2$  and  $R^3$  (in claim 1) join together to form a ring. Applicants point out that claims 3 and 4 (members classified in Group I) also specify that  $R^2$  and  $R^3$  join together to form a ring. Accordingly, there is no readily ascertainable distinction made between the claims of Group I and II, other than the fact that they have different scope (i.e. the claims of Group II are limiting), which is actually required of dependent claims under 37 C.F.R. § 1.75(c).

According to §803 of the MPEP, "If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits." Applicants note that the search and examination of claim 1 will necessarily be more extensive and inclusive of that required for claims 6 and 7. Action on Groups I and II appears to be more appropriate as a species election instead of a restriction. Applicants further note that claims 6-7 read on the elected species (Example 3), and therefore rejoinder is proper once the species is found allowable.

According to the Office Action "Group III is drawn to a distinct fluorescent composition as demonstrated by various components in the composition such as protein or polysaccharide etc." Applicants respectfully request that Group III be rejoined with Group I (and Group II) because the claims of both groups are directed to analogous prenyloxysulfonic acid structures, except that group III specifies that the prenyloxysulfonic acid compound is further conjugated to a particular component. Accordingly, co-examination of the groups will not be burdensome. In fact, a separate search and examination of the groups would be redundant and inefficient.

Furthermore, Groups IV-V and VI are directed processes for detecting analytes in a sample using the prenyloxysulfonic acid products of claims 1-10 and 11-12. "If applicant elects claim(s) directed to a product, which is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be considered for rejoinder". M.P.E.P. § 821.04(b). Applicants respectfully request rejoinder of Groups IV-VI, once the corresponding compound/composition claims are found allowable.

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"Since decisions in *In re Weber* and *In re Haas*, it is improper to refuse that which applicants regard as their invention unless the subject matter lacks unity of invention." *In re Harnish* 631 F.2d 716. Unity of invention exists when there is a technical relationship among the claimed inventions involving one or more special technical features (MPEP §1850). All the pending claims clearly share a technical relationship involving one or more special technical features, notably the prenyloxysulfonic acid compound, and therefore they have unity of invention and should be maintained in the same application.

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**CONCLUSION**

In view of the above remarks, it is submitted that this application is now ready for allowance. Early notice to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned agent at (541) 335-0165.

Respectfully submitted,

Date: \_\_\_\_\_

6/9/2006



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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Haugland <i>et al.</i>	)	Examiner: Ebenezer Sackey	18
Serial No.: 10/731,987	)	Group Art Unit: 1626	
Filed: December 9, 2003	)	Docket No. MP0088	
For: PRENYLOXYSULFONIC ACID	)		
FLUORESCENT AGENTS	)		

## MARKED-UP VERSION OF THE CLAIMS

Commissioner for Patents  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The following Marked-up Version of the Claims is hereby submitted together with the Response to Office Action on or before the initial one month due date of June 9, 2006. The Commissioner is hereby authorized to charge the Deposit Account 13-3900 the correct fee under 37 CFR § 1.16 of \$250 for a large entity.

Applicants request entry of new claims 26 and 27, which are fully supported by the Application as filed, in particular, page 55, Example 3.

## CERTIFICATE OF TRANSMISSION

I HEREBY CERTIFY THAT THIS PAPER AND THE DOCUMENTS REFERRED AS BEING ATTACHED OR ENCLOSED HERewith ARE BEING FACSIMILE TRANSMITTED TO THE UNITED STATES PATENT AND TRADEMARK OFFICE ON 6/9/06 TO 1.571.273.8300  
By Joe Sive